REMARKS

No claims have been amended, no claims have been canceled, and no new claims have been added. Claims 1-25 are therefore pending.

Claim Rejections - 35 USC § 102

The Final Office Action rejects claims 1-25 under 35 USC § 102(b) and (e) as anticipated by various references. This rejection is respectfully traversed. MPEP § 706.02 (p. 700-21) states that under 35 USC § 102, a prior art "reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." As set forth herein, each of the cited references fails to teach either explicitly or impliedly every aspect of the invention recited in the claims. Therefore, each of the claims is patentably distinct from and is patentable over the cited references.

A. Claims 1-6

The Final Office Action rejects claims 1-6 under 35 USC § 102(b) as anticipated by Petrecca (US 5,781,894). This rejection is respectfully traversed.

Claim 1 recites "A method of displaying advertisements to a user of an online service using a client application on a local device, the local device including an input device and an output device, the local device accessing an online server associated with the online service and providing interaction with the online service" and sets forth the method thereof.

The Final Office Action asserts that "the client application activating" is taught at col. 2, lines 49-56 of Petrecca. However, this portion of Petrecca is wholly irrelevant to the limitation for which it is cited. This portion of Petrecca recites that in one embodiment a "computer company incorporates a subroutine into their software product that identifies the existence of a waiting period and calls up 1 or more advertising messages from a set of advertising messages." As such, the portion of Petrecca cited by the Final Office Action fails to show where Petrecca teaches "the client application activating" as recited in claim 1.

The Final Office Action asserts that "the client application commencing an online session with the online server" is taught at col. 4, lines 1-4 of Petrecca. However, this portion of Petrecca is

wholly irrelevant to the limitation for which it is cited. This portion of Petrecca teaches facilitating registration of a software product via a modem "rather than requiring a user to call a number and talk to an operator or work through an automated system." As such, the portion of Petrecca cited by the Final Office Action fails to show where Petrecca teaches "the client application commencing an online session with the online server" as recited in claim 1.

The Final Office Action asserts that "the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label" is taught at col. 4, lines 1-4 of Petrecca. However, this portion of Petrecca is wholly irrelevant to the limitation for which it is cited. This portion of Petrecca teaches facilitating registration of a software product via a modem "rather than requiring a user to call a number and talk to an operator or work through an automated system." As such, the portion of Petrecca cited by the Final Office Action fails to show where Petrecca teaches "the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label" as recited in claim 1. Moreover, the entirety of Petrecca fails to teach this limitation.

The Final Office Action asserts that "the client application causing a client window to be displayed on the output device" is taught at col. 4, lines 62-67 of Petrecca. However, this portion of Petrecca is wholly irrelevant to the limitation for which it is cited. This portion of Petrecca teaches that an advertising presentation subroutine accesses and reads control specifications stored on a computer. As such, the portion of Petrecca cited by the Final Office Action fails to show where Petrecca teaches "the client application causing a client window to be displayed on the output device" as recited in claim 1.

The Final Office Action asserts that "the client application displaying a sponsorship label on the client window, the sponsorship label comprising a hypertext link, wherein, when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label" is taught at col. 4, lines 6-42 of Petrecca. However, this portion of Petrecca is wholly irrelevant to the limitation for which it is cited.

This portion of Petrecca teaches product activation via activation disks (col. 4, lines 6-12), activation cards (col. 4, lines 16-31) and via a charging system in the form of a cash register (col. 4, lines 32-44). As such, the portion of Petrecca cited by the Final Office Action fails to show where Petrecca teaches "the client application displaying a sponsorship label on the client window, the sponsorship label comprising a hypertext link, wherein, when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label" as recited in claim 1. Moreover, the entirety of Petrecca fails to teach these limitations.

The Final Office Action asserts that (1) "the client application causing a first advertisement to be displayed in the client window, wherein the client application retrieves the first advertisement from a memory cache local to the local device" (2) "the online server transmitting a second advertisement to the client application" and (3) "the client application causing the second advertisement to be displayed in the client window" as recited in claim 1 are all taught at col.3, lines 6-13 of Petrecca.

However, this portion of Petrecca is wholly irrelevant to the limitation for which it is cited. This portion of Petrecca teaches a method for a movie studio to advertise movies on game software. This portion of Petrecca fails to teach "the client application causing a first advertisement to be displayed in the client window" as recited in claim 1; fails to teach "the online server transmitting a second advertisement to the client application" as recited in claim 1; and fails to teach "the client application causing the second advertisement to be displayed in the client window" as recited in claim 1. As such, the portion of Petrecca cited by the Final Office Action fails to show where Petrecca teaches any portion of the three limitations recited in claim 1. Moreover, the entirety of Petrecca fails to teach these limitations.

In addition, with regard to some claims dependent on claim 1, the Final Office Action asserts that Petrecca teaches an "internet web page" at col. 2, line 34, but this portion of Petrecca recites "The value of having computer users become used to a certain software package is seen as so valuable..."; the Final Office Action asserts that Petrecca teaches "online authorization" at col. 4, line 36, but this portion of Petrecca teaches that when a purchase is made using an electronic cash register,(charging system), "the charging system automatically accesses an appropriate activation

number based on the charged price and the unique identification number of the product" ; and the Final Office Action asserts that Petrecca teaches a "title bar" at col. 2, line 53, but this portion of Petrecca teaches a "set of advertising messages"; These citations speak for themselves. As such, the portions of Petrecca cited by the Final Office Action fail to show where Petrecca teaches these limitations of the claims.

As set forth above, the Final Office Action fails to show where Petrecca teaches each and every limitation recited in the claims. Therefore, claim 1 and all claims dependent thereon are patentably distinct from and patentable over Petrecca.

B. Claims 7-10

The Final Office Action rejects claims 7-10 under 35 USC § 102(b) as anticipated by Golden (US 5,761,648). This rejection is respectfully traversed.

Claim 7 recites "A method of displaying sponsorship information to a user of an online service using a client application on a local device, the local device including an input device and an output device, the local device accessing an online server associated with the online service and providing interaction with the online service" and sets forth the method thereof. Generally, Golden teaches a system for allowing download of coupons for use by a computer user. (Golden, Abstract) As such, the entirety of the teachings of Golden can not teach the method of displaying sponsorship information recited in claim 7.

More specifically, the Final Office Action asserts that "the online server transmitting sponsorship data to the client application, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed" is taught at col. 4, lines 6-8 of Golden. However, this portion of Golden does not teach the limitation for which it is cited. This portion of Golden teaches that a consumer via a personal computer "may download no more electronic coupons than the number specified in the coupon issue instructions." The "electronic coupons" of Golden are not the same as and do not teach "the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed" as recited in claim 7. The "electronic coupons" of Golden do not include "a sponsorship object" including "a resource locator." As such, the portion of Golden cited by the Final

Office Action fails to show where Golden teaches "the online server transmitting sponsorship data to the client application" as recited in claim 7. Moreover, the entirety of Golden fails to teach this limitation.

The Final Office Action asserts that "the client application causing a client window to be displayed on the output device" is taught at col. 4, line 60 of Golden. However, this portion of Golden does not teach the limitation for which it is cited. This portion of Golden recites "A main menu is then displayed." This portion of Golden makes no mention of a window of any kind and only teaches a "main menu." As such, the portion of Golden cited by the Final Office Action fails to show where Golden teaches "the client application causing a client window to be displayed on the output device" as recited in claim 7.

The Final Office Action asserts that "the client application causing a sponsorship label to be displayed on the client window, the sponsorship label comprising a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label" is taught at col. 5, lines 64-67 of Golden. However, Golden cannot not teach these limitations because, as set forth above, Golden fails to teach the "client window" and "sponsorship label" as set forth in the preceding two paragraphs. This portion of Golden teaches that a consumer can dial up a service data base to view active coupons and select and download coupons. This portion of Golden fails to teach a "sponsorship label comprising a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label" as recited in claim 7. Further, the portion of Golden cited by the Final Office Action fails to show where Golden teaches "the client application causing a sponsorship label to be displayed on the client window" as recited in claim 7. Moreover, the entirety of Golden fails to teach this limitation.

The Final Office Action asserts that "the client application retrieving a first advertisement from a memory cache local to the local device" is taught at col. 7, lines 1-67 of Golden. However, this portion of Golden is wholly irrelevant to the limitation for which it is cited. This portion of Golden teaches a restaurant reservation system and user profiles. This portion of Golden fails to mention advertisements in any way. As such, the portion of Golden cited by the Final Office Action fails to show where Golden teaches "the client application retrieving a first advertisement from a

memory cache local to the local device" as recited in claim 7. Moreover, the entirety of Golden fails to teach this limitation.

The Final Office Action asserts that "the client application causing the first advertisement to be displayed in the client window" is taught at col. 8, lines 34-39 of Golden. However, this portion of Golden is wholly irrelevant to the limitation for which it is cited. This portion of Golden states that other accessing media would permit interactive capabilities with remote computers. This portion of Golden fails to mention advertisements and windows in any way. As such, the portion of Golden cited by the Final Office Action fails to show where Golden teaches "the client application causing the first advertisement to be displayed in the client window" as recited in claim 7. Moreover, the entirety of Golden fails to teach this limitation.

As set forth above, the Final Office Action fails to show where Golden teaches each and every limitation recited in the claims. Therefore, claim 7 and all claims dependent thereon are patentably distinct from and patentable over Golden.

C. Claims 11-14

The Final Office Action rejects claims 11-14 under 35 USC § 102(b) as anticipated by West (US 5,845,259). This rejection is respectfully traversed.

Claim 11 recites "A system for selecting advertisements for display to a user of an online service, the user utilizing the online service with a local device, wherein the local device displays advertisements from the online service the system comprising a computer program product comprising a computer usable medium having software for causing the local device to" perform various operations. Generally, West teaches an in-store system for downloading of coupons via an in-store kiosk. (West, Abstract, Fig. 1) As such, the entirety of the teachings of West can not teach the method of displaying sponsorship information recited in claim 11.

Each and every one of the citations to West made in the Final Office Action fails to teach any of the limitations recited in claim 11. Most importantly, West fails to teach an "online server" of an "online service" as recited in claim 11. Additionally, West fails to teach "sponsorship data" and a "sponsorship object" recited in claim 11. West fails to teach a "sponsorship label" having "a

hypertext ink associated with a resource locator to be accessed if a user clocks on the sponsorship label" as recited in claim 11. West fails to teach a "first advertisement" as recited in claim 11.

As set forth above, the Final Office Action fails to show where West teaches each and every limitation recited in the claims. Therefore, claim 11 and all claims dependent thereon are patentably distinct from and patentable over West.

D. Claims 15-20

The Final Office Action rejects claims 15-20 under 35 USC § 102 (e) as anticipated by Wendkos (US 5,983,196). This rejection is respectfully traversed.

Claim 15 recites "A system for selecting advertisements for display to a user of an online service, the user utilizing the online service with a local device, wherein the local device displays advertisements from the online service the system comprising a computer program product comprising a computer usable medium having software for causing the local device to" perform various operations. However, the system taught by Wendkos is an awards interaction system that provides promotional incentives to consumers. (Wendkos, Abstract, and col. 3, lines 26-43) As such, the entirety of the teachings of Wendkos can not teach the "system for selecting advertisements for display to a user of an online service" recited in claim 15.

More specifically, the Final Office Action asserts that the limitation to "obtain sponsorship data from an online server, the sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label" is taught at col. 8, lines 28-54 of Wendkos. However, this portion of Wendkos is wholly irrelevant to the limitation for which it is cited. This portion of Wendkos teaches how a "certificate database" is laid out and used to track information about how printed coupons are used by consumers. This portion of Wendkos fails to teach "sponsorship data comprising a sponsorship object including a resource locator associated with a sponsorship label to be displayed and a resource locator associated with a click-through of the sponsorship label" as recited in claim 15. Further, the portion of Wendkos cited by the Final Office Action fails to show where Wendkos teaches the limitation to "obtain sponsorship data from an online server" as recited in claim 15. Moreover, the entirety of Wendkos fails to teach all of these limitations.

The Final Office Action asserts that the limitation to "display a sponsorship label on the client window, the sponsorship label comprising a hypertext link, wherein, when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label" is taught at col. 16, lines 49-66 of Wendkos. However, this portion of Wendkos is wholly irrelevant to the limitation for which it is cited. This portion of Wendkos recites "a flow chart of how an awards interaction in accordance with the invention can be invoked during execution of another program." Further, this portion of Wendkos teaches rewarding a player of an interactive game when a certain level of proficiency is achieved, and upon the occurrence of other events or conditions. This portion of Wendkos fails to teach a "sponsorship label" that includes "a hypertext link" as recited in claim 15. As such, the portion of Wendkos cited by the Final Office Action fails to show where Wendkos teaches to "display a sponsorship label on the client window, the sponsorship label comprising a hypertext link, wherein, when the user clicks through on the sponsorship label, the client application causes the local device to access the resource locator associated with a click-through of the sponsorship label" as recited in claim 15. Moreover, the entirety of Wendkos fails to teach this limitation.

The Final Office Action asserts that the limitations to "retrieve a first advertisement from a local memory cache" and to "obtain a second advertisement from the online server" are taught at col. 15, lines 40-53 of Wendkos. However, this portion of Wendkos is wholly irrelevant to the limitation for which it is cited. This portion of Wendkos teaches a method of implementing an instant win module and discusses a participant database, a number of wins, and instant win credits. Wendkos fails to teach a "first advertisement" and a "second advertisement" as recited in the claims. As such, the portion of Wendkos cited by the Final Office Action fails to show where Wendkos teaches the limitations to "retrieve a first advertisement from a local memory cache" and to "obtain a second advertisement from the online server" as recited in claim 15. Moreover, the entirety of Wendkos fails to teach these limitations.

The Final Office Action asserts that the limitations to "display the first advertisement in the client window" and to "display the second advertisement in the client window" are taught at col. 16, lines 39-48 of Wendkos. However, this portion of Wendkos is wholly irrelevant to the limitations for which it is cited. This portion of Wendkos teaches "an exemplary computer architecture of a

computer terminal." This portion of Wendkos merely recites the well known components included in a personal computer. Wendkos fails to teach a "first advertisement" and a "second advertisement" as recited in the claims. As such, the portion of Wendkos cited by the Final Office Action fails to show where Wendkos teaches the limitations to "display the first advertisement in the client window" and to "display the second advertisement in the client window" as recited in claim 15. Moreover, the entirety of Wendkos fails to teach these limitations.

As set forth above, the Final Office Action fails to show where Wendkos teaches each and every limitation recited in the claims. Therefore, claim 15 and all claims dependent thereon are patentably distinct from and patentable over Wendkos.

E. Claims 21-25

The Final Office Action rejects claims 21-25 under 35 USC § 102(b) as anticipated by Lalonde (US 5,283,731). This rejection is respectfully traversed.

Claim 21 recites "A method of displaying advertisements to a user of an online service using a client application on a local device, the local device including an input device and an output device, the user using the local device for accessing an online server and a web server associated with the online service" and the actions associated therewith. However, the system taught by Lalonde is a computerized system for placing and viewing classified ads that also alerts users who have a corresponding want ad to newly placed classified ads. (Lalonde, Abstract) By its very nature a directory of classified ads and methods of placing ads is wholly different from the advertisements recited in claim 21. In addition, the actions taken in Lalonde as a whole are not accomplished by and do not involve a "client application" as recited in claim 21. As such, the entirety of the teachings of Lalonde can not teach the "method of displaying advertisements to a user of an online service" recited in claim 21.

More specifically, the Final Office Action asserts that "the client application monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction, the usage history being descriptive of the subject matter of the data that the user accessed from the web server" is taught at col. 6, lines 31-41 of Lalonde. However, this portion of Lalonde is not related to the limitation for which it is cited. This portion of Lalonde teaches

obtaining information for a new ad from a seller. As such, the portion of Lalonde cited by the Final Office Action fails to show where Lalonde teaches "the client application monitoring the user's interaction with the client window and assembling a usage history for the user based on the user's interaction, the usage history being descriptive of the subject matter of the data that the user accessed from the web server" as recited in claim 1. Moreover, the entirety of Lalonde fails to teach this limitation.

The Final Office Action asserts that all of the following limitations of claim 21 are taught at col. 7, lines 17-22 of Lalonde:

> f) the client application receiving an instruction from the user to terminate the online session;
>
> g) the client application displaying an exit window on the output device of the local device, wherein the exit window includes an advertisement box associated with an exit window advertisement;
>
> h) the online server identifying an exit window advertisement for display to the user based upon the usage history, wherein a subject matter of the exit window advertisement is related to the subject matter described in the usage history;
>
> i) the online server transmitting instructions to the local device to display the exit window advertisement in the advertisement box of the exit window;
>
> j) the client application causing the exit window advertisement to be displayed in the advertisement box of the exit window.

However, the cited portion of Lalonde is wholly irrelevant to the limitations for which it is cited. This portion of Lalonde (col. 7, lines 17-22) recites

> At this point, the operator determines if the seller has another new ad to place. If so, then the above described steps are repeated. If not, then processing proceeds to block 170 to perform various accounting functions, and the placement of the ad by the seller is complete.

This portion of Lalonde refers to the steps taken to complete the placement of a classified advertisement show in Fig. 3 of Lalonde which sets forth the steps taken to create a new ad in an ad database. (Lalonde, col. 6, lines 19-23, *et seq.*) As such, the portion of Lalonde cited by the Final Office Action fails to show where Lalonde teaches these limitations of claim 21.

More specifically, Lalonde fails to teach "the client application receiving an instruction from the user to terminate the online session" as recited in claim 21; Lalonde fails to teach "the client application displaying an exit window on the output device of the local device, wherein the exit window includes an advertisement box associated with an exit window advertisement" as recited in claim 21; Lalonde fails to teach "the online server identifying an exit window advertisement for display to the user based upon the usage history, wherein a subject matter of the exit window advertisement is related to the subject matter described in the usage history" as recited in claim 21; Lalonde fails to teach "the online server transmitting instructions to the local device to display the exit window advertisement in the advertisement box of the exit window" as recited in claim 21; and Lalonde fails to teach "the client application causing the exit window advertisement to be displayed in the advertisement box of the exit window" as recited in claim 21.

As set forth above, the Final Office Action fails to show where Lalonde teaches each and every limitation recited in the claims. Therefore, claim 21 and all claims dependent thereon are patentably distinct from and patentable over Lalonde.

Claim Rejections - 35 USC § 103

The 35 USC § 103(a) obvious rejections have been withdrawn.

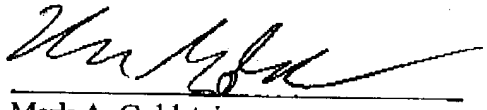
Conclusion

In view of all of the above, it is respectfully submitted that the Final Office action be withdrawn and reissued as a regular Office Action because the Final Office Action

The Examiner is invited to call the undersigned attorney to answer any questions or to discuss steps necessary for moving prosecution of this matter forward..

Respectfully submitted,

Date: June 30, 2004



Mark A. Goldstein
Reg. No. 50,759

SoCal IP Law Group
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362
Telephone: 805/230-1350 x24
Facsimile: 805/230-1355
mgoldstein@socalip.com